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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,782	08/27/2001	Jason D. Alic	18360/218130	2833
826	7590	02/27/2006	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/939,782

Applicant(s)

ALIE ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-9,11-21,24,25,28,29 and 31-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-9,11-21,24,25,28,29 and 31-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Response to Amendment**

The final office action mailed on 31 March 2005 is withdrawn. All pending claims (1-3, 5-9, 11-21, 24, 25, 28, 29, and 31-45) were examined in this non-final office action necessitated by new grounds of rejection

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-3, 5-9, 11-21, 24, 25, 28, 29, and 31-45 have been considered but are moot in view of the new ground(s) of rejection. Previously cited prior art was withdrawn.

### ***Requirement for Information***

An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: a) web pages, press releases, white papers, and any marketing materials resulting from UPS-Nescrow relationship as identified in Item U; and b) web pages, press releases, white papers, and any marketing materials resulting from UPS-Venta.com relationship as identified in Item UU.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1, 2, 3, 5, 12, 25, and 38-45 are rejected under 35 USC 103(a) as being unpatentable over Rodgers (a collection of prior art cited in PTO-892, Items: U and V) in view of Walker (US 6,108,639).**

Rodgers teaches Nescrow.com being -founded by Bill Rodgers (i.e. William Rodgers) a buyer and seller meeting through an online auction site, a newspaper classified or any number of other venues and registering at Nescrow.com.

Rodgers teaches once the buyer and seller agree to a sale price and registering at Nescrow.com, UPS is notified, a label is printed, and a driver is dispatched to retrieve the seller's package. Once the package is in UPS's hands, Nescrow.com is notified and the buyer's credit card or wire transfer payment is placed in an escrow account (U: see at least page 2; V: see at least abstract; line 1). Rodgers further teaches:

- Receiving the package at a first location using a delivery service: once the package is in UPS's hands (please note: a first delivery location) (U: see at least page 2).

- Receiving shipment order information on the package using an information system: once price is agreed on and the sale has been registered, UPS will be notified, a label will be printed (please note: shipping information), and a driver will be dispatched to retrieve the package (U: see at least page 2).
- Receiving the payment associated with the package from the purchaser's funds, funds held in escrow: once the package is in UPS's hands, Nescrow.com is notified and the buyer's credit card or wire transfer payment is placed in an escrow account (U: see at least page 2); Nescrow.com partnering with Discover Card to process all the credit card transactions through the site (please note: a payment system) (U: see at least page 2).
- In response to receiving the payment verification, transmitting the release command to the delivery system using the information system: Inherent in Rodgers are the structures necessary to permit a release command to instruct the delivery system after receiving payment verification. For example, a buyer's credit card or wire transfer payment is placed in an escrow account (U: see at least page 2). The buyer has five days to inspect the product (please note: purpose is to release the seller's goods once buyer's credit card is verified or wire transfer is received) (U: see at least page 3).

- While payment is in escrow, transmitting the release command to the delivery system using the information system: Inherent in Rodgers are the structures necessary to permit transmitting a release command to the delivery system. For example, the carrier has possession of goods at a first location and then a buyer's credit card or wire transfer payment is placed in an escrow account (U: see at least page 2). The buyer has five days to inspect the product (please note: purpose of Rodgers is to ensure payment to escrow account is verified before goods are released to the buyer) (U: see at least page 3; V: see at least pages 3-5).
- Releasing the hold command: Inherent in Rodgers are the structures necessary to permit releasing the hold command. For example, the carrier delivered goods from a first location to buyer for inspection indicating the system gave the carrier received permission to release the delivery to the buyer (U: see at least page 2).
- Delivery verification: Inherent in Rodgers are the structures necessary to permit receiving a delivery verification at the information system. For example, the system gives the buyer five days to inspect the product and must know when to begin the five-day inspection period (U: see at least page 2).
- Transmitting a distribution command out of escrow to seller funds account: payment is transferred to seller (U: see at least page 2).

- Transaction numbers: Inherent in Rodgers are the structures necessary to permit the processing and tracking of an individual transaction by identifying information unique to the transaction. For example, Rodgers teaches associating a transaction with the buyer and seller within a central system that manages multiple transactions among a plurality of buyers and sellers conducting electronic commerce and communicating transaction information between buyer, seller, payment system (U: see pages 1-3; V: pages
- Hub and spoke: central computer of Nescrow.com communicates with bank computer, remote buyer computers, and seller computers (U: see at least pages 1-3; V: see at least Fig. 1 (100); pages 6-8).
- Carriers: UPS, Federal Express, USPS (U: see pages 1-3); V: see at least page 9, lines 1-2).

Rodgers teaches all the above as noted under 35 USC 103(a) and teaches a) using an escrow service if the buyer and seller are participating in an online auction site, newspaper classified ad site, or other buyer-seller venues, b) using an escrow service to prevent fraud (U: see pages 1 and 2), c) a carrier moving a seller's goods to a buyer under the control of an escrow service to a first location, and further teaches the collectibles community as another venue where escrow services may be used (U: see at pages 2 and 3). Rodgers, however, does not disclose specifics about a collectibles venue. Walker teaches an online collectibles system that brings buyers and sellers for one or more collectibles

(e.g. coins, stamps, art, jewelry) and teaches the use of escrow services. Walker teaches a number assigned to identify the conditional purchase offer (i.e. CPO number associates the transaction between buyer and seller), and teaches once a seller accepts an offer, but before completing the transaction, the goods are preferably forwarded to a dealer/authenticator for evaluation. The dealer/authenticator preferably validates, authenticates and optionally guarantees the goods, while also serving as the distribution point for the collectibles sold by the collectibles management system (please note: distribution point is an intermediate location) (see at least abstract; Fig. 1; col. 3, lines 39-44). Walker further teaches validation establishing the item actually exists, and authentication providing the item is in the condition stated by the accepting seller. Walker teaches the, guarantee, if desired, insures that the buyer has not purchased a counterfeit item or an item of unacceptable quality. Once an item is delivered to the dealer/authenticator and approved (please note: automatically held until approval gains release), the dealer/authenticator can deliver the item to the buyer and authorize payment to the accepting seller (see at least col. 3, lines 44-55). Please note: system moves package to intermediate location, held at intermediate location. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Rodgers to transport a seller's goods to an intermediate location as taught by Walker, in order to validate and authenticate a seller's goods using an intermediate location that holds and releases goods to a buyer upon payment,



and thereby attract buyers to the service wanting protection against counterfeit items or unacceptable item quality.

Pertaining to system claims

Rejection of claims 1, 2, 3, 5, 12, and 38-45 is based on the same rationale as noted above.

2. **Claims 6-9, 11, 13-21, 24, and 35-37 are rejected under 35 USC 103(a) as being unpatentable over Rodgers (a collection of prior art cited in PTO-892, Items: U and V) and Walker (US 6,108,639), as applied to claims 1, and 12, further in view of Murray (PTO-892, Item: W).**

Rodgers and Walker teach and suggest all the above as noted under the 103(a) rejection and teach and suggest a) solving a fraud problem on the Internet worldwide, b) holding a package at an intermediate location, and c) UPS as a local carrier participating with the escrow service, but does not disclose the first location being a first country and the intermediate location being a second country. Murray teaches cash-on-delivery as a substitute for letter of credit and UPS as a carrier providing cash-on-delivery services for buyers and sellers (X: see title; page 2, 4, and 6). Murray teaches cash-on-delivery services for shipments destined for foreign countries (e.g. cited by Murray: Louisiana case) and teaches customs brokers (X: see page 12). Murray teaches international sales whereby parties sell on a payment against a sight draft on order bills of lading without the use of a letter of credit. Murray further teaches an American

seller (i.e. Allied Chemicals International Corp) selling a quantity of chemicals to a Brazilian buyer, the goods being loaded on the carrier (please note: a first country and first location at port of origin), the goods arriving in Brazil (i.e. a second country), the goods being unloaded and placed in custody of the port authority as required by law (please note: an intermediate location in a second country), releasing goods to buyer, and the American seller suing the carrier (X: see pages 17 and 18). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Rodgers and Walker to disclose cash-on-delivery services as an alternative to letters of credit, cash-on-delivery as method of payment for international sales, customs brokers handling import/export, a second delivery location as an intermediate location in a second country, carriers local to their country delivering goods based on cash-on-delivery or other payment methods, and goods being released from intermediate location as taught by Murray, in order to disclose to sellers and buyers cash-on-delivery as an alternative to letters of credit for international sales, and thereby increasing buyers' and seller's interest in cash-on-delivery services from local and international carriers.

3. **Claims 28, 29, and 31-34 are rejected under 35 USC 103(a) as being unpatentable over Rodgers (a collection of prior art cited in PTO-892, Items: U and V) and Walker (US 6,108,639), as applied to claim 25, further in view of Thompson (PTO-892, Item: W).**

Rodgers and Walker teach and suggest all the above as noted under the 103(a) rejection and teach and suggest a) solving a fraud problem on the Internet worldwide, b) a first location and holding a package at an intermediate location, and c) UPS as a carrier participating with the escrow service, but does not disclose clearing the package for export from the first location is a first country using an export brokerage and clearing the package to the intermediate location using an import brokerage before moving the package to the intermediate location in a second country. Thompson teaches 85% of firms cannot ship across borders because it is too complex. Thompson teaches UPS as shipping most of the goods ordered on the Internet and being a rival to FedEx. Thompson teaches Global Trade Manager as being a FedEx service that helps solve Customs issues before they start. The wizard-based process helps shippers identify and prepare the appropriate import/export forms (please note: used for clearing customs at origin and destination). Thompson further teaches domestic customers arranging shipments to or from the United States (please note: at least United States is a first country or second country), Canada, United Kingdom, Hong Kong, and Puerto Rico. Inherent in Murray are the structures necessary to permit local carrier participation. For example, UPS and FedEx provide local carrier service in at least the United States and Canada. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Rodgers and Walker to provide services to prepare documents necessary for import/export as taught by

Thompson, in order to help businesses conduct cross-borders commerce, and  
thereby attract sellers to the service.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

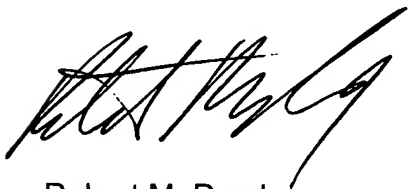
- US 6,934,692 (Duncan) 23 August 2005; teaches a system and method transacting business between multiple buyers and sellers utilizing an escrow service.
- Venta.com; "United Parcel Service Mexico signs first strategic alliance with online B2B marketplace Venta.com," PR Newswire, 30 May 2000, Proquest #54335955, 3pgs; teaches UPS and Venta.com forming alliance to provide groundbreaking logistics services in the B2B category; Venta.com providing physical and financial escrow services.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 703-605-4253. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Robert M. Pond', is written over a horizontal line.

Robert M. Pond  
Primary Examiner  
February 21, 2006